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2617

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/800,899	Applicant(s) KAWAI, EIJI	
	Examiner Farzana E. Hossain	Art Unit 2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-73 is/are pending in the application.
- 4a) Of the above claim(s) ^{12-17 +} ~~52-56~~ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11, 18-51, 57-73 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 12-17, 52-56 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>05-24-02</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C.

121:

- I. Claims 1-11, 18-51 and 57-73, drawn to a receiver with advertisements displayed based on user interaction, classified in class 725, subclass 32.
- II. Claims 12-17 and 52-56, drawn to a transmitter with a data inserter, classified in class 725, subclass 144.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention II has separate utility such as data that is inserted could be data other than advertisements. See MPEP § 806.05(d).

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

During a telephone conversation with Thomas Presson on 08-31-05 a provisional election was made with traverse to prosecute the invention of Group

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I, Claims 1-11, 18-51, and 57-73. Affirmation of this election must be made by applicant in replying to this Office action. Claims 12-17, 52-56 withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Objections

2. Claims 33-36 are objected to because of the following informalities: "said tuber." The Office assumes "said tuber" is "said tuner." Appropriate correction is required.
3. Claim 45 is objected to because of the following informalities:
The claim recites "when of an advertisement video image in which the priority." The Office assumes "when an advertisement video image in which the priority." The claim recites "plurality of said advertisement." The Office assumes "plurality of said advertisements." Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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5. Claims 5 and 23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. Claim 5 recites the limitation "said broadcasting infrastructure" in Line 3. There is insufficient antecedent basis for this limitation in the claim. The Office assumes "in the case of using said broadcasting infrastructure" to be "in the case of using a broadcasting infrastructure."

7. Claim 23 recites the "wherein a priority is set to the electronic information contents downloaded from the advertisement specific channel, are displayed." The previous limitation is unclear. The Office assumes "wherein a priority is set to the electronic information contents downloaded from the advertisement specific channel, are displayed" to be "wherein a priority is set to the electronic information contents downloaded from the advertisement specific channel, and the electronic information contents with a set priority are displayed."

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an

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application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claim 1-4, 6, 11, 38-41, 46-47 are rejected under 35 U.S.C. 102(e) as being anticipated by Reynolds et al (US 6,799,327 and hereafter referred to as "Reynolds").

Regarding Claims 1 and 38, Reynolds discloses an electronic information content distribution processing system (Figure 1, 30) of distributing electronic information contents (Column 6, lines 8-31) containing an advertisement (Column 6, lines 8-31), and processing electronic information contents at the user side (Figures 1 and 2, 48), the system comprising: an information distribution apparatus (Figures 1 and 2, 38) for distributing the electronic information contents (Column 6, lines 8-31) to a user (Figures 1 and 2, 48); and a plurality of information processing apparatuses (Figures 1 and 2, 48) for receiving (Column 5, lines 63-66) and storing the electronic information contents distributed from the information distribution apparatus (Column 6, lines 26-28), reading out the electronic information contents according to operation of the user (Column 6, lines 61-67, Column 7, lines 1-10), and processing the electronic information contents (Column 4, lines 37-43), and then outputting an advertisement video image and audio (Figure 5, 62, 64).

Regarding Claims 2 and 39, Reynolds discloses all the limitations of Claims 1 and 38 respectively. Reynolds discloses that electronic information contents contain video image element information and audio information concerning advertisement (Column 6, lines 8-11) whose information can be operated by the user (Figure 4A); and program information for processing these

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items of information are contained in the electronic information contents (Column 4, lines 39-43, Figure 4A).

Regarding Claims 3 and 40, Reynolds discloses all the limitations of Claims 1 and 38 respectively. Reynolds discloses there is provided an advertisement specific channel for distributing only the electronic information contents concerning the advertisement (Column 5, lines 46-66).

Regarding Claims 4 and 47, Reynolds discloses all the limitations of Claims 1 and 38 respectively. Reynolds discloses that the electronic information contents are provided so as to be distributed using existing broadcasting infrastructure or communication infrastructure (Figure 1, 46, Column 6, lines 22-23).

Regarding Claim 6, Reynolds discloses all the limitations of Claim 1. Reynolds discloses that the information distribution apparatus is provided so as to distribute the electronic information contents concerning the advertisement through the advertisement specific channel assigned in advance (Column 5, lines 46-65).

Regarding Claims 11 and 46, Reynolds discloses all the limitations of Claims 1 and 38 respectively. Reynolds discloses that the information processing apparatus processes the electronic information contents (Column 4, lines 39-43), and displays an advertisement video image that consists of a three-dimensional video image (Figure 5, 62, 64).

Regarding Claim 41, Reynolds discloses all the limitations of Claim 40. Reynolds discloses electronic information contents concerning a plurality of the

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advertisement are distributed by using the advertisement specific channel

(Column 5, lines 46-66).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 5 and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reynolds in view of Zigmond et al (US 6,698,020 and hereafter referred to as "Zigmond").

Regarding Claims 5 and 48, Reynolds discloses all the limitations of Claims 1 and 47 respectively. Reynolds discloses that in the case of using a broadcasting infrastructure, at least broadcasting information contents concerning an arbitrary broadcasting program (Column 4, lines 52-64) and electronic information contents concerning the advertisement (Column 4, lines 52-64) are constructed in a group of data. Reynolds does not disclose the data are transmitted to be multiplexed in a vertical blanking period of a television broadcast signal adopted at the broadcasting infrastructure. Zigmond discloses the data are transmitted to be multiplexed in a vertical blanking period of a television broadcast signal adopted at the broadcasting infrastructure. (Column

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8, lines 39-54). Therefore, it would have been obvious at the time the invention was made to one of ordinary skill in the art to modify Reynolds to include that electronic information contents are received from the broadcasting information infrastructure during a vertical blanking period (Column 8, lines 39-54) as taught by Zigmond in order to specifically target viewers who are interested in the advertisement (Column 3, lines 45-67) as disclosed by Zigmond.

12. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Reynolds in view of Hite et al (US 6,002,393 and hereafter referred to as "Hite").

Regarding Claim 7, Reynolds discloses all the limitations of Claim 1.

Reynolds discloses the information processing apparatus comprises: user interface allowing operation input concerning the electronic information contents to pass through (Figure 1, 54); a receiver for receiving the electronic information contents (Figure 1, 48); a local storage for the electronic information contents received by the receiver (Column 6, lines 26-28); and a control device for reading out the electronic information contents from the storage device according to the operation input passed through the user interface, and information processing the electronic information contents, thereby displaying and controlling an advertisement video image (Column 4, lines 39-43). Reynolds does not explicitly disclose that the local storage is a non-volatile storage device for the electronic information contents received by the receiver. Hite discloses that receiver has a non-volatile storage device for the electronic information contents received by the receiver (Column 12, lines 3-18). Therefore, it would have been

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obvious at the time the invention was made to one of ordinary skill in the art to modify Reynolds to indicate that the local storage is non-volatile storage (Column 12, lines 3-18) as taught by Hite in order to facilitate the substitution of targeted commercials without concern of timing (Column 12, lines 3-27) as disclosed by Hite.

13. Claims 8 and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reynolds in view of Ward et al (US 2005/0010949 and hereafter referred to as "Ward").

Regarding Claims 8 and 49, Reynolds discloses all the limitations of Claims 1 and 38 respectively. Reynolds discloses in the case where broadcasting information contents concerning an arbitrary program (Column 4, lines 52-64) and the electronic information contents concerning the advertisement (Column 4, lines 52-64) are transmitted to be multiplexed by an existing broadcasting infrastructure (Figure 1), the information processing apparatus displays (Figure 1, 48), an advertisement video image based on the electronic information contents. Reynolds does not disclose that the display is prior to displaying the broadcasting information contents. Ward discloses that the advertisement is displayed prior to the broadcasting information contents (Page 4, paragraph 0252). Therefore, it would have been obvious at the time the invention was made to one of ordinary skill in the art to modify Reynolds to display an advertisement prior to broadcasting information contents (Page 4,

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paragraph 0252) as taught by Ward in order allow advertisements to be viewed if the power was turned off (Page 4, paragraph 0252) as disclosed by Ward.

14. Claims 9, 10, 50, 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reynolds in view of Ward as applied to claim 8 and 49 above, and further in view of Zigmond.

Regarding Claims 9 and 50, Reynolds discloses all the limitations of Claims 8 and 49 respectively. Reynolds and Ward do not disclose when the display of the broadcasting information contents is terminated; the information processing apparatus displays the advertisement video image. Zigmond discloses when the display of the broadcasting information contents is terminated; the information processing apparatus displays the advertisement video image (Column 15, lines 45-65). Therefore, it would have been obvious at the time the invention was made to one of ordinary skill in the art to modify Reynolds in view of Ward to after the display of the broadcasting information contents, the information processing apparatus displays the advertisement video image (Column 15, lines 45-65) as taught by Zigmond in order to specifically target viewers who are interested in the advertisement (Column 3, lines 45-67) as disclosed by Zigmond.

Regarding Claims 10 and 51, Reynolds and Ward disclose all the limitations of Claims 8 and 49 respectively. Reynolds in view of Ward does not disclose when the advertisement video image is displayed the information processing apparatus executes a control program so as to select whether to set

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a mode for displaying the broadcasting information contents or a mode for continuously displaying the advertisement video image. Zigmond discloses when the advertisement video image is displayed the information processing apparatus executes a control program (Column 6, lines 48-67) so as to select whether to set a mode for displaying the broadcasting information contents or a mode for continuously displaying the advertisement video image (Column 8, lines 30-54). Therefore, it would have been obvious at the time the invention was made to one of ordinary skill in the art to modify Reynolds in view of Ward to allow a control program to set a mode of advertisement or broadcasting information contents (Column 6, lines 48-67, Column 8, lines 30-54) as taught by Zigmond in order to specifically target viewers who are interested in the advertisement (Column 3, lines 45-67) as disclosed by Zigmond.

15. Claims 42-45 rejected under 35 U.S.C. 103(a) as being unpatentable over Reynolds in view of Ellis et al (US 2004/0194131 and hereafter referred to as "Ellis").

Regarding Claim 42, Reynolds discloses all the limitations of Claim 40. Reynolds does not disclose a priority for displaying a number of images is set, in advance prior to another advertisement video image, in any of the electronic information contents downloaded from the advertisement specific channel. Ellis discloses a priority for displaying a number of images is set, in advance prior to another advertisement video image, in any of the electronic information contents downloaded from the advertisement specific channel (Page 9, paragraph 0130).

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Therefore, it would have been obvious at the time the invention was made to one of ordinary skill in the art to modify Reynolds to include a priority so that a number of images is displayed in advance to other downloaded contents (Page 9, paragraph 0130) as taught by Ellis in order to schedule advertisement for presentation (Page 1, paragraph 0002).

Regarding Claim 43, Reynolds and Ellis disclose all the limitations of Claim 42. Reynolds does not disclose an advertisement video image in which the priority is set is displayed prior to displaying an advertisement video image in which the priority is not set. Ellis discloses an advertisement video image in which the priority is set is displayed prior to displaying an advertisement video image in which the priority is not set or is a default priority (Page 10, paragraph 0136).

Regarding Claim 44, Reynolds and Ellis disclose all the limitations of Claim 42. Reynolds does not disclose an advertisement video image in which the priority is set is displayed after terminating the displaying of an advertisement video image in which the priority is not set. Reynolds does not disclose an advertisement video image in which the priority is set is displayed after terminating the displaying of an advertisement video image in which the priority is not set or default or displaying the advertisements in a continuous loop (Page 10, paragraph 0138). Therefore, it would have been obvious to one of ordinary skill in the art to display a primary set priority advertisement after displaying a default set priority advertisement as taught by Ellis.

Regarding Claim 45, Reynolds and Ellis disclose all the limitations of Claim 42. Reynolds does not disclose when an advertisement video image in which the priority is set is displayed; a control program is executed so as to select arbitrary electronic information contents from among the electronic information contents concerning a plurality of the advertisements. Ellis discloses when an advertisement video image in which the priority is set is displayed; a control program is executed so as to select arbitrary electronic information contents from among the electronic information contents concerning a plurality of the advertisements (Page 10, paragraph 0137). It would have been obvious that an arbitrary electronic information contents to be chosen if all priority set contents are displayed.

16. Claims 18, 32, 57, 71, 73 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reynolds in view of Knee et al (US 2002/0095676 and hereafter referred to as "Knee").

Regarding Claim 18, Reynolds discloses an information processing apparatus (Figures 1 and 2, 48) for information processing electronic information contents (Column 6, lines 8-31) containing an advertisement (Column 6, lines 8-31), the apparatus characterized by comprising means for receiving (Column 5, lines 63-66) and storing the electronic information contents (Column 6, lines 26-28). Reynolds discloses reading electronics information according to user operation (Column 6, lines 61-67, Column 7, lines 1-10) and then processing the electronic information contents (Column 4, lines 37-43) and outputting an advertisement video image and audio (Figure 5, 62, 64). Reynolds does not

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disclose reading out of the electronic information contents according to a user's information operation. Knee discloses reading out the electronic information contents according to a user's information operation (Page 2, paragraph 0017, Page 3, paragraph 0029). Therefore, it would have been obvious at the time the invention was made to one of ordinary skill in the art to modify Reynolds to read out electronic information contents based on user information operation (Page 2, paragraph 0017, Page 3, paragraph 0029) as taught by Knee in order to more readily allow the user to view advertisements according to their operation (Page 1, paragraph 007) as disclosed by Knee.

Regarding Claim 57, Reynolds discloses an information processing method comprising the steps of: receiving (Column 5, lines 63-66) and storing electronic information contents (Column 6, lines 26-28) containing video image element information and audio information concerning an advertisement that can be operated (Column 6, lines 8-31, Figure 4A). Reynolds discloses program information for processing these items of information (Column 4, lines 37-430. Reynolds discloses reading electronics information according to user operation (Column 6, lines 61-67, Column 7, lines 1-10) and then processing the electronic information contents (Column 4, lines 37-43) and outputting an advertisement video image and audio after the electronic information contents have been processed (Figure 5, 62, 64). Reynolds does not disclose reading out of the electronic information contents according to a user's information operation. Knee discloses reading out the electronic information contents according to a user's information operation (Page 2, paragraph 0017, Page 3, paragraph 0029).

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Therefore, it would have been obvious at the time the invention was made to one of ordinary skill in the art to modify Reynolds to read out electronic information contents based on user information operation (Page 2, paragraph 0017, Page 3, paragraph 0029) as taught by Knee in order to more readily allow the user to view advertisements according to their operation (Page 1, paragraph 007) as disclosed by Knee.

Regarding Claim 32, Reynolds and Knee disclose all the limitations of Claim 18. Reynolds discloses an information processing apparatus (Figure 1, 48) with a tuner (Column 5, lines 63-65) that receives and stores the electronic information contents (Column 5, lines 63-65, Column 6, lines 26-28); and a monitor device for reading out electronic information contents from the composite processing device according to user operation (Column 5, 52), and outputting an advertisement video image and audio information after the electronic information contents have been information processed asynchronously (Figure 5, 62, 64, Column 4, lines 37-43). Reynolds does not disclose reading out of the electronic information contents according to a user's information operation. Knee discloses reading out the electronic information contents according to a user's information operation (Page 2, paragraph 0017, Page 3, paragraph 0029).

Regarding Claim 71, Reynolds and Knee disclose all the limitations of Claim 57. Reynolds discloses a combined processing apparatus with tuner receiving (Column 5, lines 63-65) and storing the electronic information contents is provided (Column 6, lines 26-28), and electronic information contents are read out from the combined processing apparatus according to user's operation

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(Column 6, lines 59-65), and the advertisement video image and audio information obtained after the electronic information contents have been processed is output (Figure 5).

Regarding Claim 73, Reynolds and Knee disclose all the limitations of claim 57. Reynolds does not disclose details on the communications path. Knee discloses receiving electronic information contents distributed by using a telephone line (Figure 1, 46).

17. Claims 19-22, 27, 33, 36, 58, 59-61, 66, 72 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reynolds in view of Knee as applied to claim 18, 32 above, and further in view of Hite.

Regarding Claim 19, 33, 58, Reynolds and Knee disclose all the limitations of Claims 18, 32, 57 respectively. Reynolds discloses the information processing apparatus comprising an operating unit operated in order to provide operation input concerning the electronic information contents (Figure 1, 54), a tuner or a receiver for receiving the electronic information contents (Figure 1, 48, Column 5, lines 63-65); a local storage for the electronic information contents received by the receiver (Column 6, lines 26-28); and a control device or computing unit for reading out the electronic information contents from the storage device according to the operation input provided by the operation unit, and information processing the electronic information contents, thereby displaying and controlling an advertisement video image (Column 4, lines 39-43). It is inherent that a controller exists with the computing unit in order to control the

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displayed advertisement video image. Reynolds in view of Knee does not explicitly disclose that the local storage is a non-volatile storage device for the electronic information contents received by the receiver. Hite discloses that receiver has a non-volatile storage device for the electronic information contents received by the receiver (Column 12, lines 3-18). Therefore, it would have been obvious at the time the invention was made to one of ordinary skill in the art to modify Reynolds in view of Knee to indicate that the local storage is non-volatile storage (Column 12, lines 3-18) as taught by Hite in order to facilitate the substitution of targeted commercials without concern of timing (Column 12, lines 3-27) as disclosed by Hite.

Regarding Claims 20 and 59, Reynolds, Knee, and Hite disclose all the limitations of Claims 19 and 58 respectively. Reynolds discloses that apparatus causes the storage device to download a plurality of the electronic information contents distributed through an advertisement specific channel (Column 6, lines 26-28, Column 5, lines 46-65). Hite discloses that the storage device is non-volatile (Column 12, lines 3-18).

Regarding Claims 21 and 60, Reynolds, Knee, and Hite disclose all the limitations of Claims 19 and 58 respectively. Reynolds discloses a means for reading out electronic information contents concerning an arbitrarily selected advertisement from electronic information contents concerning a plurality of the advertisements downloaded on the storage device (Column 6, lines 26-28, Column 7, lines 8-15), and reproducing an advertisement video image and audio based on the electronic information contents (Figure 5).

Regarding Claims 22 and 61, Reynolds, Knee, and Hite disclose all the limitations of Claims 19 and 58 respectively. Reynolds discloses the control device processes the electronic information contents, and displays and controls an advertisement video image that consists of a three-dimensional video image (Column 4, lines 39-43, Figure 4A).

Regarding Claims 27 and 66, Reynolds, Knee, and Hite disclose all the limitations of Claims 19 and 58 respectively. Reynolds discloses in the case where video image element and audio information concerning an advertisement whose information can be operated in the electronic information contents (Column 6, lines 59-67, Column 7, lines 1-7); and program information for processing these items of information are contained (Column 4, lines 39-43), electronic information contents downloaded on the storage device are read out (Column 6, lines 59-67), the video image element information and audio information are processed based on the program information, (Column 4, lines 39-43) thereby reproducing an advertisement video image and audio (Figure 5).

Regarding Claims 36, Reynolds, Knee, and Hite disclose all the limitations of Claims 18 and respectively. Reynolds discloses the information processing apparatus comprises: a tuner for receiving the electronic information contents (Column 5, lines 63-65) a local storage for the electronic information contents received by the receiver (Column 6, lines 26-28); and a data processing unit for processing the electronic information contents read out from the storage device (Column 4, lines 39-43). Reynolds discloses an operation unit that includes remote control, keyboard, trackball, and a display remote (Figure 1, 54). It is

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inherent that these device to have an operation key to be operated in order to control the data processing unit. Reynolds discloses a display unit for displaying an advertisement video image or a program video image operated by the operation key (Figure 1, 54). Reynolds discloses a hand held terminal device is configured (Column 5, lines 1-20). Reynolds does not explicitly disclose that the local storage is a non-volatile storage device for the electronic information contents received by the receiver. Hite discloses that receiver has a non-volatile storage device for the electronic information contents received by the receiver (Column 12, lines 3-18). Therefore, it would have been obvious at the time the invention was made to one of ordinary skill in the art to modify Reynolds to indicate that the local storage is non-volatile storage (Column 12, lines 3-18) as taught by Hite in order to facilitate the substitution of targeted commercials without concern of timing (Column 12, lines 3-27) as disclosed by Hite.

Regarding Claim 72, Reynolds, Knee, and Hite disclose all the limitations of Claim 57. Reynolds discloses receiving the electronic information contents (Column 5, lines 63-65); storing the received electronic information contents in a storage device (Column 6, lines 26-28); generating the advertisement video image based on the electronic information read out from the storage device (Figure 5); and processing the advertisement video image based on an operation of an external controller (Figure 1, 54). Reynolds does not disclose a non-volatile storage device. Hite disclose a non-volatile storage device (Column 12, lines 3-18). Therefore, it would have been obvious at the time the invention was made to one of ordinary skill in the art to modify Reynolds to indicate that the

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local storage is non-volatile storage (Column 12, lines 3-18) as taught by Hite in order to facilitate the substitution of targeted commercials without concern of timing (Column 12, lines 3-27) as disclosed by Hite.

18. Claims 23-26 and 62-65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reynolds in view of Knee and Hite as applied to Claim 20 and 59 above, and further in view of Ellis.

Regarding Claims 23 and 62, Reynolds discloses all the limitations of Claims 20 and 59 respectively. Reynolds does not disclose a priority for displaying a number of images is set, in advance prior to another advertisement video image, in any of the electronic information contents downloaded from the advertisement specific channel. Ellis discloses a priority for displaying a number of images is set, in advance prior to another advertisement video image, in any of the electronic information contents downloaded from the advertisement specific channel (Page 9, paragraph 0130). Therefore, it would have been obvious at the time the invention was made to one of ordinary skill in the art to modify Reynolds to include a priority so that a number of images is displayed in advance to other downloaded contents (Page 9, paragraph 0130) as taught by Ellis in order to schedule advertisement for presentation (Page 1, paragraph 0002).

Regarding Claims 24 and 63, Reynolds discloses all the limitations of Claims 23 and 62 respectively. Reynolds does not disclose an advertisement video image in which the priority is set is displayed prior to displaying an

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advertisement video image in which the priority is not set. Ellis discloses an advertisement video image in which the priority is set is displayed prior to displaying an advertisement video image in which the priority is not set or is a default priority (Page 10, paragraph 0136).

Regarding Claims 25 and 64, Reynolds discloses all the limitations of Claims 23 and 62 respectively. Reynolds does not disclose an advertisement video image in which the priority is set is displayed after terminating the displaying of an advertisement video image in which the priority is not set. Reynolds does not disclose an advertisement video image in which the priority is set is displayed after terminating the displaying of an advertisement video image in which the priority is not set or default or displaying the advertisements in a continuous loop (Page 10, paragraph 0138). Therefore, it would have been obvious to one of ordinary skill in the art to display a primary set priority advertisement after displaying a default set priority advertisement as taught by Ellis.

Regarding Claims 26 and 65, Reynolds discloses all the limitations of Claims 23 and 62 respectively. Reynolds does not disclose when an advertisement video image in which the priority is set is displayed; a control program is executed so as to select arbitrary electronic information contents from among the electronic information contents concerning a plurality of the advertisements. Ellis discloses when an advertisement video image in which the priority is set is displayed; a control program is executed so as to select arbitrary electronic information contents from among the electronic information contents

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concerning a plurality of the advertisements (Page 10, paragraph 0137). It would have been obvious that an arbitrary electronic information contents to be chosen if all priority set contents are displayed.

19. Claims 28 and 67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reynolds in view of Knee and Hite and in further view of Zigmond.

Regarding Claims 28 and 67, Reynolds discloses all the limitations of Claims 19 and 58 respectively. Reynolds discloses that in the case of where electronic information contents are received from an existing broadcasting infrastructure (Figure 1, 38, 46). Reynolds does not disclose the data are transmitted in a vertical blanking period of a television broadcast signal adopted at the broadcasting infrastructure. Zigmond discloses the data are transmitted in a vertical blanking period of a television broadcast signal adopted at the broadcasting infrastructure. (Column 8, lines 39-54). Therefore, it would have been obvious at the time the invention was made to one of ordinary skill in the art to modify Reynolds to include that electronic information contents are received from the broadcasting information infrastructure during a vertical blanking period (Column 8, lines 39-54) as taught by Zigmond in order to specifically target viewers who are interested in the advertisement (Column 3, lines 45-67) as disclosed by Zigmond.

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20. Claims 29-31 and 68-70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reynolds in view of Knee, Hite, and Zigmond as applied to Claim 58 above, and further in view of Ward.

Regarding Claims 29 and 68, Reynolds, Knee, Hite and Zigmond disclose all the limitations of Claims 28 and 67 respectively. Reynolds discloses in the case where broadcast information contents are received from the broadcasting infrastructure (Figure 1, 38). Reynolds does not disclose that the display is prior to displaying the broadcasting information contents. Ward discloses that the advertisement is displayed prior to the broadcasting information contents (Page 4, paragraph 0252). Therefore, it would have been obvious at the time the invention was made to one of ordinary skill in the art to modify Reynolds to display an advertisement prior to broadcasting information contents (Page 4, paragraph 0252) as taught by Ward in order allow advertisements to be viewed if the power was turned off (Page 4, paragraph 0252) as disclosed by Ward.

Regarding Claims 30 and 69, Reynolds, Knee, Hite, Zigmond, and Ward disclose all the limitations of Claims 29 and 68 respectively. Reynolds, Knee, Hite, and Ward do not disclose when the display of the broadcasting information contents is terminated; the information processing apparatus displays the advertisement video image. Zigmond discloses when the display of the broadcasting information contents is terminated; the information processing apparatus displays the advertisement video image (Column 15, lines 45-65). Therefore, it would have been obvious at the time the invention was made to one of ordinary skill in the art to modify Reynolds in view of Knee, Hite, and Ward to

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after the display of the broadcasting information contents, the information processing apparatus displays the advertisement video image (Column 15, lines 45-65) as taught by Zigmond in order to specifically target viewers who are interested in the advertisement (Column 3, lines 45-67) as disclosed by Zigmond.

Regarding Claim 31 and 70, Reynolds, Knee, Hite, Zigmond, and Ward disclose all the limitations of Claims 29 and 70 respectively. Reynolds, Knee, Hite, and Ward do not disclose when the advertisement video image is displayed the information processing apparatus executes a control program so as to select whether to set a mode for displaying the broadcasting information contents or a mode for continuously displaying the advertisement video image. Zigmond discloses when the advertisement video image is displayed the information processing apparatus executes a control program (Column 6, lines 48-67) so as to select whether to set a mode for displaying the broadcasting information contents or a mode for continuously displaying the advertisement video image (Column 8, lines 30-54). Therefore, it would have been obvious at the time the invention was made to one of ordinary skill in the art to modify Reynolds in view of Knee, Hite, Ward to allow a control program to set a mode of advertisement or broadcasting information contents (Column 6, lines 48-67, Column 8, lines 30-54) as taught by Zigmond in order to specifically target viewers who are interested in the advertisement (Column 3, lines 45-67) as disclosed by Zigmond.

21. Claims 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over Reynolds in view of Knee as applied to claim 18 above, and further in view of

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Beyers et al (US 5,943,467 and hereafter referred to as "Beyers") and Darbee et al (US 2002/0184626 and hereafter referred to as "Darbee").

Regarding Claim 34, Reynolds and Knee disclose all the limitations of Claim 18. Reynolds discloses that the information processing apparatus includes a tuner device for receiving the electronic information contents (Column 5, lines 63-65), a hand held terminal device (Figure 1, 54) and a display unit for displaying at least an advertisement video image or a program video image operated by the operation key (Column 5, lines 11-20). However, Reynolds and Knee do not disclose a hand held terminal device mountable to the tuner device, characterized in that the hand held terminal device comprises: a non-volatile storage device for storing at least the electronic information contents; a computing unit for reproducing the advertisement video image based on the electronic information contents read out from the storage device; an operation key operated in order to control the computing unit; and a display unit for displaying at least an advertisement video image or a program video image operated by the operation key. Beyers discloses a hand held terminal device mountable to the tuner device (Column 2, lines 17-23). Darbee discloses the hand held terminal device comprises: a non-volatile storage device for storing at least the electronic information contents (Figure 2, 42); a computing unit for reproducing the advertisement video image based on the electronic information contents read out from the storage device (Figure 2, 28); an operation key operated in order to control the computing unit (Figure 1, 10, 15). Therefore, it would have been obvious at the time the invention was made to modify Reynolds

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in view of Knee to include at the hand held terminal device a non-volatile storage device for storing at least the electronic information contents (Figure 2, 42); a computing unit for reproducing the advertisement video image based on the electronic information contents read out from the storage device (Figure 2, 28); an operation key operated in order to control the computing unit (Figure 1, 10, 15) as taught by Darbee in order to specifically target viewers who are interested in specific advertisement (Page 1, paragraphs 0008-0009) as disclosed by Darbee. Therefore, it would have been obvious at the time the invention was made to modify Reynolds in view of Knee to include the hand held terminal device to be mountable to the tuner device (Column 2, lines 17-23) as disclosed by Beyer in order to transmit data between the hand held terminal and a VCR or receiver (Column 2, lines 12-25) as disclosed by Beyers.

22. Claims 35 is rejected under 35 U.S.C. 103(a) as being unpatentable over Reynolds in view of Knee, Beyers and Darbee as applied to claim 34 above, and further in view of Hite.

Regarding Claim 35, Reynolds and Knee disclose all the limitations of Claim 35. Reynolds discloses a storage device is located at the tuner device (Column 6, lines 66-68). Reynolds in view of Knee and Darbee does not explicitly disclose that the local storage is a non-volatile storage device for the electronic information contents received by the receiver. Hite discloses that receiver has a non-volatile storage device for the electronic information contents received by the receiver (Column 12, lines 3-18). Therefore, it would have been

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obvious at the time the invention was made to one of ordinary skill in the art to modify Reynolds in view of Knee, Beyers and Darbee to indicate that the local storage is non-volatile storage (Column 12, lines 3-18) as taught by Hite in order to facilitate the substitution of targeted commercials without concern of timing (Column 12, lines 3-27) as disclosed by Hite.

23. Claims 37 is rejected under 35 U.S.C. 103(a) as being unpatentable over Reynolds in view of Knee and Hite as applied to claim 36 above, and further in view of Darbee.

Regarding Claim 37, Reynolds, Knee, and Hite disclose all the limitations of Claim 36. Reynolds, Knee and Hite do not disclose a communication modem is provided at the hand held terminal device so as to receive the electronic information contents distributed by using an existing communication infrastructure. Darbee discloses a communication modem is provided at the hand held terminal device so as to receive the electronic information contents distributed by using an existing communication infrastructure (Page 6, Paragraph 0077). Therefore, it would have been obvious at the time the invention was made to modify Reynolds in view of Knee and Hite to include a communication modem is provided at the hand held terminal device so as to receive the electronic information contents distributed by using an existing communication infrastructure (Page 6, Paragraph 0077) as taught by Darbee in order to specifically target viewers who are interested in specific advertisement (Page 1, paragraphs 0008-0009) as disclosed by Darbee.

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Conclusion


24. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Alexander et al (US 6,177,931).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Farzana E. Hossain whose telephone number is 571-272-5943. The examiner can normally be reached on Monday to Friday 8:00 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Kelley can be reached on 571-272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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